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# FAX

<b>To:</b>	<b>Examiner Sirmons</b>	<b>From:</b>	<b>Neil D. Gershon</b>
<b>Fax:</b>	<b>571 273-8300</b>	<b>Pages:</b>	<b>3 (including this cover sheet)</b>
<b>Group:</b>	<b>3763</b>	<b>Date:</b>	<b>February 28,2006</b>
<b>Re:</b>	<b>In re application of McGuckin, Jr.</b>	<b>Docket:</b>	<b>1908</b>
<b>Serial No. 10/074,468</b>			
<b>Filing Date: February 12, 2002</b>			

Examiner Sirmons:

As requested, enclosed is the communication from the European Patent Office citing U.S. Patent No. 5,558,673 (D3). Note the D1 and D2 documents referenced in the communication are U.S. Patent No. 6,080,150 and 5,980,517, respectively, which were both of record in the above-noted '468 application. (see IDS filed October 9, 2002). Note Applicants' European application was granted in December 2005.

Neil Gershon

	<input checked="" type="checkbox"/> EPA/EPO/OEB D-80298 München  <input type="checkbox"/> +49 89 2399-0 TX 523 656 epmu d FAX +49 89 2399-4465	<b>Europäisches Patentamt</b>  Generaldirektion 2	<b>European Patent Office</b>  Directorate General 2	<b>Office européen des brevets</b>  Direction Générale 2
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<div style="border: 1px solid black; padding: 5px; text-align: center;"> <b>DEREK JACKSON ASSOCIATES</b>  <b>25 JAN 2005</b>  <b>RECEIVED</b> </div>				
Application No. 02 719 064.4 - 2305		Ref. P0867	Date 21.01.2005	
Applicant Rex Medical, L.P.				

**Communication pursuant to Article 96(2) EPC**

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

*Response due  
21 May 2005*

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

**Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).**



Stern, M  
 Primary Examiner  
 for the Examining Division

Enclosure(s): 1 page/s reasons (Form 2906)  
 Document US-A-5 558 673 (D3)



Bescheid/Protokoll (Anlage)		Communication/Minutes (Annex)		Notification/Procès-verbal (Annexe)	
Datum Date Date	21.01.2005	Blatt Sheet Feuille	1	Anmelde-Nr.: Application No.: 02 719 064.4 Demande n°:	

The examination is being carried out on the **following application documents**:

**Description, Pages**

2-22	as published			
1	received on	08.01.2005	with letter of	06.01.2005

**Claims, Numbers**

5 (part), 6-15	received on	01.09.2003	with letter of	29.08.2003
1-4, 5 (part)	received on	08.01.2005	with letter of	06.01.2005

**Drawings, Sheets**

1/23-23/23	as published
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- Even if the examining division may accept the view that claim 1 fulfills the requirement of novelty, claim 1 is not patentable for lack of an inventive step (Art. 56 EPC). Although D1 and D2 are silent as to how the fluid delivery members are moved and held in their positions, it is obvious for the skilled person that if the disclosed devices are to be useful for carefully introducing the fluid delivery members into the desired tissue site, the disclosed devices would be provided with an actuator for moving the fluid delivery members and a retention member for retaining the fluid delivery members in the chosen positions.

✓

In particular, document **US-A-5 558 673** (which was not cited in the search report and is hereinafter referred to as D3; copy enclosed; cf Guidelines C-VI, 8.9) discloses such features for the mentioned purpose.

- D3 discloses these features as recited in claims 4 and 5 of the application, ie, it discloses a housing with an axially slideable actuator of fluid delivery members, on which an actuator tab is mounted which is engageable with one of a plurality of recesses formed in the housing, and with a retention member for retaining the fluid delivery members in the chosen positions (cf in D3, Figs. 1, 2; column 4, lines 30-33 and 57-65; column 3, lines 53-56).

Hence, also dependent claims 4 and 5 are not patentable for lack of an inventive step. As indicated under point 3 of the preceding communication, also the other claims 2, 3 and 6-15 do not contain further features which would provide an inventive step over the cited prior art.